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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,242	11/16/2006	Gerardo Caja Lopez	Q-92179	8695

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EXAMINER	
LACYK, JOHN P	

ART UNIT	PAPER NUMBER
3735	

MAIL DATE	DELIVERY MODE
02/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/563,242	CAJA LOPEZ ET AL.	
	Examiner	Art Unit	
	John P. Lacyk	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9* is/are rejected.

7)☒ Claim(s) *8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al (2001/0001176) in view of Platt (5,937,789).

Caja Lopez et al discloses a capsule located in a stomach of an animal. Caja Lopez et al teaches that in prior art devices, that it is well known to use a capsule having a length of about 75mm and a diameter of about 18 mm and have a device whose density exceeds 2 g/cm3 (paragraph 0003). The Caja Lopez et al device, specifically, has a density of "not less than 3.5 g/cm3" and a weight of 65-60 g, length of 69mm and a diameter of 20mm (see Table 1 and paragraph 0023). While Caja Lopez et al does teach a density of not less than 3.5 g/cm3, which would include being equal to or greater than 4 g/cm3, Caja Lopez et al does not specifically teach a density equal to or greater than 4 g/cm3 or a specific gravity equal to or greater than 3. Platt discloses a similar capsule and teaches that the body should have a density of at least 3 g/cm3 and a specific gravity of at least 4. Platt further discloses that the density needs to be sufficiently high so that the incidence of rejection may be minimized and that it is well known to use a material including zirconium oxide (which would inherently have a density equal to or greater than 4 g/cm3) (see abstract and column 2, line 48- column 3, line 3). Therefore a modification of Caja Lopez et al such that the material used is a zirconium oxide would have been obvious in view of the teachings of Platt which show

that it is well known to use such a material with a capsule in order to provide the desired density and specific gravity to maintain the device in the animal.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed 10/27/08 have been fully considered but they are not persuasive. Applicant argues that Platt teaches away from using a ceramic capsule because they are relatively time-consuming and costly to manufacture. While this may teach that ceramic is not the most preferred material it does teach that it is well known to use a capsule of ceramic material and an obviously known material to one skilled in the art. Just because something is time consuming to make and costly to manufacture does not teach that it will not work only that it may not be the preferred material for some and is still obvious to one skilled in the art. Further Platt does teach using zirconium oxide, which is considered to be a ceramic material. Platt was used to provide a teaching that the device should have a sufficient density and gravity to minimize rejection of the device. Therefore to make the Caja Lopez et al device from a zirconium oxide would have been obvious to one skilled in the art in order to provide a density and gravity sufficient to prevent or minimize rejection of the device as taught by Platt.

Applicant also argues that neither Caja Lopez et al or Platt disclose the combination of features of claim 1. Neither describe that the dimensions of the bolus are a critical factor in retaining the bolus in the stomach and in particularly the length of the capsule. Caja Lopez et al clearly teaches using a bolus sized within the claimed range, including a length of 69 mm, a diameter of 20 mm and a weight of 65-60 g. While Caja Lopez et al may not specifically state using such sizes for the same reason, it clearly teaches a device having the claimed size and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is (571)272-4728. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Marmor, II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.P. Lacyk

/John P Lacyk/
Primary Examiner, Art Unit 3735